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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/698,697	10/31/2003	Randall B. Noble	KMC-603	1903

7590
09/23/2004
Darrell F. Marquette
2201 W. Desert Cove
Phoenix, AZ 85029

EXAMINER

BLAU, STEPHEN LUTHER

ART UNIT	PAPER NUMBER
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3711

DATE MAILED: 09/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/698,697

Applicant(s)

NOBLE ET AL.

Examiner

Stephen L. Blau

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 August 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) 2 and 4 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3 and 5-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 10/31/03
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. This application contains claims directed to the following patentably distinct species of the claimed invention:

Type of Shaft locating device/bore

- a. Species 1 (Figs. 5-6):
- b. Species 2 (Fig. 3):
- c. Species 3 (No groove, Page 7, Lns. 12-14):

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, it is uncertain what claims are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims

are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

2. During a telephone conversation with Mr. Darrell F. Marquett on 13 August 2004 a provisional election was made without traverse to prosecute the invention of species 2 (Fig. 3), claims 1-3 and 5-22. Affirmation of this election must be made by applicant in replying to this Office action. Claim 4 is withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention. The examiner also considers claim 2 as not being directed to the elected species of figure 3. Figure 3 has the upper portion of the shaft locating device extending upwardly above the upper end of the bore inner surface. Claim 2 requires the upper portion of the shaft locating device being substantially flush with the upper end of the bore inner surface which is disclosed in page 8 lines 20-24 which is another embodiment different than figure 3. As such, claim 2 is also withdrawn from further consideration by the examiner.

3. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1, 3, 5, 7, 10-11,13, and18 are rejected under 35 U.S.C. 102(b) as being anticipated by Chappell.

Chappell discloses a shaft locating device having an upper portion, a lower portion and an outer peripheral surface conforming to the shape of at least a portion of an inner surface of an upper end of a bore, the upper portion of the shaft locating device extending upwardly above the upper end of the bore inner surface (Fig. 2), a portion of an outer peripheral surface of an shaft locating device being configured to form an

interference fit with an inner surface of an upper end of a bore (Col. 3, Lns. 57-61), an iron (Claim 12), a portion of a tip end of a shaft is affixed with an adhesive to at least a portion of an inner surface of an lower end of a bore of a head (Col. 3, Lns. 53-58), and a plastic shaft locating device (Col. 3, Lns. 32-40).

6. Claim 1, 8, and 22 are rejected under 35 U.S.C. 102(e) as being anticipated by Helmstetter.

Helmstetter discloses a shaft locating device (50) having an upper portion, a lower portion and an outer peripheral surface conforming to the shape of at least a portion of an inner surface of an upper end of a bore (Ref. Nos. 54, 56), and a driver (Abstract).

7. Claims 1, 9, and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Butler.

Butler discloses a shaft locating device (16) having an upper portion, a lower portion and an outer peripheral surface conforming to the shape of at least a portion of an inner surface of an upper end of a bore (Fig. 2), a putter (Col. 2, Lns. 8-13), and a shaft locating device having a uniform diameter in the form of an outer and inner uniform diameter (Col. 2, Lns. 60-65).

8. Claims 1, 12 and 19 are rejected under 35 U.S.C. 102(e) as being anticipated by Boone.

Boone discloses a shaft locating device in the form of the top hosel body (Figs 10i, 10j, 10k) having an upper portion, a lower portion and an outer peripheral surface conforming to the shape of at least a portion of an inner surface of an upper end of a bore (Ref. No. 29, Figs. 5, 10i, 10j, 10k), and an outer peripheral surface of a shaft locating device being affixed with an adhesive to an inner surface of an upper end of a bore (Col. 4, Lns. 50-55).

9. Claims 1, 14, 17 and 20-21 are rejected under 35 U.S.C. 102(e) as being anticipated by Abe.

Abe discloses a method and a shaft locating device (Ref. No. 22, Figs. 3a, 3) having an upper portion, a lower portion and an outer peripheral surface conforming to the shape of at least a portion of an inner surface of an upper end of a bore (Fig. 3a), a groove is disposed around an upper end of a bore of a head and at least a portion of a shaft locating device is seated in a groove (Fig. 3a), and a tolerance between a shaft locating device and a shaft is less than the tolerance between a bore of a head and a shaft (Fig. 3a).

10. Claims 1 and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Smith.

Smith discloses a shaft locating device (Ref. No. 32) having an upper portion, a lower portion and an outer peripheral surface conforming to the shape of at least a portion of an inner surface of an upper end of a bore (Fig. 2), and a lower end of a bore

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of a head having a narrowed portion and a bottom end of a shaft seated in the narrow portion (Fig. 2).

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chappel in view of Bamber.

Chappel lacks a portion of a shaft locating bore configured to form an interference fit with a least a portion of a shaft.

Bamber discloses that as well as attaching a shaft to a hosel with adhesive, it is also known to attach a shaft to a hosel using a friction fit (Col. 7, Lns. 5-20). In view of the patent of Bamber it would have been obvious to modify the club of Chappel to have a portion of a shaft locating bore configured to form an interference fit with a least a portion of a shaft in order to not have to have adhesive to secure a shaft to a hosel.

Conclusion

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13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steve Blau whose telephone number is (703) 308-2712.

The examiner is available Monday through Friday from 8 a.m. to 4:30 p.m.. If the examiner is unavailable you can contact his supervisor Greg Vidovich whose telephone number is (703) 308-1513. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0858. (TC 3700 Official Fax 703-872-9306)

slb/ 16 August 2004


STEPHEN BLAU
PRIMARY EXAMINER